

REMARKS

In the Office Action, the Examiner objected to claim 1 and rejected claims 1-32. By this paper, Applicant has amended claim 1 to correct an antecedent basis problem, amended claims 4, 10, and 17 to clarify certain features, and added new claims 33-42. These amendments do not add any new matter. Upon entry of these amendments, claims 1-42 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims.

Claim Objections

In the Office Action, the Examiner objected to claim 1 because “the lifting mechanism” lacks antecedent basis. Applicant has amended claim 1 to correct this antecedent basis problem. As such, Applicant respectfully requests the withdrawal of the objection to claim 1.

Claim Rejections under Doctrine of Obviousness-Type Double Patenting

In the Office Action, the Examiner rejected claims 1-28 under the judicially created doctrine of obviousness-type double patenting over claims 1, 3-8 and 10-12 of U.S. Patent No. 6,678,154 B2, which is the parent of the present continuing application. Although Applicant does not agree that the present claims 1-28 are obvious over claims 1, 3-8 and 10-12 of the U.S. Patent No. 6,678,154 B2, Applicant is willing to file a terminal disclaimer if necessary when the claims are indicated as allowable.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 7-11, 14-17, and 22-27 under U.S.C. § 102(b) as anticipated by Ohgami et al. (U.S. Patent No. 5,764,477). Applicant respectfully traverses this rejection.

Legal Precedent

First, anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicant need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Second, when construing claims, the Federal Circuit has consistently looked first to dictionaries, encyclopedias, and treatises, which were publicly available at the time the patent issued, to determine the ordinary and custom meanings of terms used in claims. As stated in *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-03 (Fed. Cir. 2002):

Such references are unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, not colored by the motives of the parties, and not inspired by litigation. Indeed, these materials may be the most meaningful source of information to assist judges in better understanding both the technology and the terminology used by those skilled in the art to describe the technology.

The *Texas Digital* court further stated that “[c]onsulting the written description and prosecution history as a threshold step in the claim construction process, before any effort

is made to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims.” *Id.* at 1204 (cited with approval in *Intellectual Property Development Inc. v. UA-Columbia Cablevision of Westchester Inc.*, 67 U.S.P.Q. 2d 1385, 1389 (Fed. Cir. 2003)).

Deficiencies of the Rejection

Applicant respectfully asserts that several features of independent claims 7, 14, and 22 and dependent claim 2 are not disclosed by the Ohgami reference. For example, independent claim 7 recites “a lifter having a sloped structure leading to an *inwardly angled structure*” and “a boss movable along the sloped structure to a lifted position at the *inwardly angled structure*, whereat a mating angled structure of the boss is retainable against *the inwardly angled structure*.” (emphasis added). Independent claim 14 recites “a lifter having a sloped structure leading to an *angled retention structure*” and “a boss movable along the sloped structure to a lifted position at the *angled retention structure*, whereat a mating *angled structure* of the boss is retainable against the *angled retention structure*.” (emphasis added). Independent claim 22 recites “a lifter having a sloped structure leading to an *angled retention structure*; and a boss movable along the sloped structure to a lifted position at the angled retention structure, whereat a mating *angled structure* of the boss is retainable against the *angled retention structure*.” (emphasis added). Dependent claim 2 recites “[t]he component mount of claim 1, wherein the retention structure and the mating retention structure comprises *angled abutment surfaces*.” (emphasis added).

In contrast, the Ohgami reference discloses a *convex* portion 42 that moves along cam surface 65 to a *concave* cavity 67. *See* Figs.18B; col. 9, line 62 – col. 10, line 5. Applicant submits that “angled” may be defined as “having an angle or angles” and that “angle” may be defined as “the space within two or more lines or three or more planes diverging from a common point.” THE RANDOM HOUSE COLLEGE DICTIONARY 51-52

(Rev. Ed. 1988). In light of this, Applicant asserts that neither the convex portion 42 nor the cavity 67 disclosed in the Ohgami reference can be considered the “angled structure,” as recited in claims 7, 14, and 22 or the “angled abutment surfaces” recited in claim 2. For these reasons, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 102 against claims 2, 7, 14, and 22 as well as those claims that depend from them.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-6, 12-13, 18-19, 20-21 and 28-32 under 35 U.S.C. § 103(a) as obvious over Ohgami et al (U.S. Patent No. 5,764,477). Applicant respectfully traverses this rejection.

Legal Precedent

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).). The Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “*well within the*

ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Second, Applicant reminds that Examiner that there is no *per se* rule that duplication of parts is obvious. In order to establish a *prima facie* case of obviousness, the Examiner must explain why the “reference itself would have fairly suggested, to one of ordinary skill in the art, the desirability” of the duplication. *See Ex Parte Granneman*, 68 U.S.P.Q.2d 1219 (Bd. Pat. App. & Inter. 2003). The mere fact that the prior art could be modified as proposed by the examiner is *simply not sufficient* to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Third, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Detailed Rejection

In the Office Action, the Examiner specifically stated:

Claims 1-6, 12-13, 18-19, 20-21, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohgami et al.

Ohgami discloses the claimed invention except an additional boss and an additional lifter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Ohgami with an additional boss and an additional lifter, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. See MPEP §2144.04 VI, B.

Office Action, page 6, lines 13-19.

Deficiencies of the Rejection

In the Office Action, as evidenced by the above-quoted section, the Examiner conceded that the sole cited reference does *not* disclose all of the recited features of the rejected claims. That is, even assuming that the Examiner's interpretation of the Ohgami reference is correct, the Examiner nonetheless expressly conceded that Ohgami does not disclose an additional boss and an additional lifter." See page 6, lines 15-16. However, to satisfy this deficiency, the Examiner, in a conclusory manner, asserted that "[i]t would have been obvious...to modify the device of Ohgami with an additional boss and an additional lifter...since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art." Page 6, lines 16-18.

As support for this proposition, the Examiner cited Section 2144.04 (VI)(B) of the M.P.E.P. Applicant, however, respectfully asserts that the Examiner has *misapplied* this section of the M.P.E.P. to establish a *per se* rule that duplication of parts involves only routine skill in the art. In contrast, the Board of Patent Appeals and Interferes has recently made it clear that the both M.P.E.P. §2144.04 and *In re Harza* (the case upon which M.P.E.P. §2144.04(VI)(B) is based) *does not* establish a *per se* rule that duplication of parts is obvious. See *Ex Parte Granneman*, 68 U.S.P.Q.2d 1219, 1220

(Bd. Pat. App. & Inter. 2003); *see also In re Ochiai*, 37 U.S.P.Q.2d 1127, 1133 (Fed. Cir. 1995) (holding that “reliance on per se rules of obviousness is legally incorrect and must cease.”). With this in mind, Applicant respectfully asserts that the Examiner’s conclusory statement does not *demonstrate* that a “plurality of bosses,” as recited in independent claims 1, 20, or 29 are either obvious or well known in the art.

Furthermore, the Examiner does not assert that the Ohgami reference contains any motivation or suggestion to modify the device disclosed therein to reach the claimed subject matter. In fact, the Examiner has not presented any *objective evidence* of the requisite motivation or suggestion to modify the Ohgami reference that could lead the ordinary artisan to make the modifications that the Examiner believes “would be obvious.”

Moreover, the Examiner has not even asserted that a plurality of bosses are “well known.” To the extent the Examiner’s rejection could be so interpreted, Applicant seasonably traverses and challenges the Examiner’s use of “Official Notice.” *See* M.P.E.P. § 2144.03. Even if the Examiner has taken Official Notice, Applicant respectfully asserts that such an action is improper. Official Notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well known or to be common knowledge in the art are capable of *instant and unquestionable demonstration* as being well known. *See id.* In the instant case, Applicant asserts that the use of a plurality of bosses is not “unquestionably” well known in the art. Thus, as emphasized above, the Examiner must present some evidence to present a *prima facie* case of obviousness.

Undeniably, a *prima facie* case of obviousness cannot be established by simply asserting that a recited feature is obvious. Rather, the Examiner’s unsupported allegation of obviousness suggests that the Examiner has, at best, used the teachings of the application as a road map to reach the instant claims. The Federal Circuit has warned that

the Examiner must not “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)). Avoiding hindsight reconstruction is especially important regarding less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to employ such hindsight. *See id.* Therefore, without any proper supporting evidence, the Examiner’s summary statement regarding what “would have been obvious” is, again at best, impermissible hindsight reconstruction.

Because the Examiner has not demonstrated a *prima facie* case of obviousness, Applicant is not required to submit any argument or evidence to rebut such a showing. However, even if the Examiner had demonstrated a *prima facie* case of obviousness, the appropriate legal precedent holds that an alleged duplication of part is *not* obvious if a new and unexpected result is produced. *See In re Harza*, 124 U.S.P.Q. 378, 380 (C.C.P.A. 1960); M.P.E.P. §2144.04(VI)(B). With regard to the instant application, the Examiner has ignored a number of advantages that the claimed invention presents over the device of the Ohgami reference. For example, a plurality of bosses, as recited in independent claims 1, 20, and 29 provides additional stability to the claimed component mount in comparison to the battery module disclosed in the Ohgami reference. Specifically, the *plurality* of bosses on the component mount supports lifting of the component mount at two or more points thereby improving stability. This enables lifting of the component mount in a smooth and consistent manner such that the module does not tend to tip, cock, or bind as it is repeatedly inserted and removed. Furthermore, the employment of a plurality of bosses also decreases the amount of lifting force applied to each boss. As such, the respective bosses of the claimed invention are less likely to be damaged in comparison to the single boss design of the Ohgami reference. Applicant notes that these are but some of the advantages of the claimed invention over the device of the Ohgami reference. Clearly, the claimed invention presents new and unexpected

results in comparison to the device of the cited reference, and, as such, is not an obvious “duplication of parts.”

In closing, Applicant reiterates that the Examiner bears the burden of establishing a *prima facie* case of obviousness. With that in mind, Applicant respectfully asserts that the foregoing remarks clearly establish that the Examiner has failed to satisfy the evidentiary thresholds. Indeed, conclusory statements cannot satisfy the Examiner’s burdens. Accordingly, Applicant respectfully asserts that independent claims 1, 20, and 29, and the claims that depend therefrom, are patentable over the cited reference and in condition for allowance.

New Claims 33-42

Applicant respectfully requests that new independent claims 33-42 be considered. The claims are fully supported by the specification. Applicant respectfully submits that the Ohgami reference does not disclose the subject matter recited in these new claims. For example, new claim 33 recites “[t]he component mount of claim 1, wherein the mating retention structure of the lifter is configured *to block movement* of the plurality of bosses from the lifted position to a recessed position.” (emphasis added). New Claim 34 recites “the lifter comprises a *plurality of lift tabs*,” and new claim 35 recites “the component mount of claim 34, wherein one of the plurality of lift tabs comprises a substantially *flat recessed surface*, which is *configured to support* one of the plurality of bosses when the component is in the lifted position.” (emphasis added). The Ohgami reference clearly does not disclose these limitations or the limitations set forth in new claims 36-42. As such, Applicant respectfully asserts that these claims 33-42 are clearly not anticipated by the Ohgami reference and requests allowance of new claims 33-42.

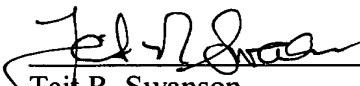
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Conclusion

Applicant respectfully submits that all pending claims should be in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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